Appl. No. 09/663,554
Amdt. dated 9/20/2004
Reply to Office Action of May 20, 2004

REMARKS/ARGUMENTS

Amendments

The claims are modified in the amendment. More specifically, claims 1-22 have been amended and new claims 23-28 have been added. Therefore, claims 1, 3-8, 10-15 and 17-28 are present for examination. No new matter is added by these amendments. Applicant respectfully requests reconsideration of this application as amended.

35 U.S.C. §112 Rejection

Claims 8, 10-15 and 17-20 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter. Claims 8 and 15 are amended in a manner that doesn't affect claim scope to provide antecedent basis for "the time value."

35 U.S.C. §103 Rejections, Prasad et al. in view of Blood et al. and/or Ma et al.

The Office Action has rejected claims 8 and 10-14 under 35 U.S.C. §103(a) as being unpatentable over the cited portions of U.S. Patent No. 6,539,381 to Prasad et al. (hereinafter "Prasad") in view of the cited portions of U.S. Patent No. 6,202,067 to Blood et al. (hereinafter "Blood"). Next, the Office Action rejects claims 1, 3-7 and 21-22 under 35 U.S.C. §103(a) as being unpatentable over Prasad in view of the cited portions of U.S. Patent No. 6,347,313 to Ma et al. (hereinafter "Ma"). Finally, the Office Action has rejects claims 1, 3-7 and 21-22 under 35 U.S.C. §103(a) as being unpatentable over Prasad in view of Ma and further in view of Blood.

The patent office (the "Office") is charged with putting forth a *prima facie* showing of obviousness. Applicants believe a *prima facie* case of obviousness has not been properly set forth in the final Office Action. The basic test is excerpted below:

> "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally,

PATENT

the prior art reference (or references when combined) must teach or suggest all the claim limitations.
The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in the applicant's disclosure." See MPEP §2143, Original Eighth Edition, August, 2001, Latest Revision May 2004.

Applicants believe the rejection has flaws with all three prongs of the above test for establishing a *prima facie* case of obviousness. For least these reasons, Applicants respectfully request for reconsideration of the rejection to the claims.

Teachings Missing from the Cited References

With regard to the third prong of the test, Applicants believe Prasad, Blood or Ma do not, either alone or in combination, teach or suggest the invention in the claims. More specifically, none of Prasad, Blood or Ma teach or suggest: (1) a network content directory that receives content directories as required by all claims; (2) a directory listing content objects identified with content object class as required by claims 1, 8 and 15; or, (3) performing reporting of the directory in response to detecting a timer value as required by claims 8 and 15.

Summary of Cited References

Prasad relates to a distributed database that can be updated in a peer-to-peer manner between various database replicas 109. See Prasad, col. 3, lines 13-24. The objects in the database are of various types, such as printers, users, servers, and applications, but the objects are not classified based upon their content. See Prasad, col. 8, lines 24-26. Synchronizing a distributed database is a significant problem, but is dealt with by using timestamps. See Id., col. 3, lines 46-51. The timestamps merely indicate a time that the directory changed and do not have anything to do with timers. See Id., col. 13, line 58 through col. 14, line 2.

Blood teaches use of a timer that is started in step 260 after beginning a transaction in step 250. Blood, Fig. 3A. If the timer expires as detected in step 300 before the transaction completes, the transaction is aborted in step 310. This timer is not related to triggering the reporting directory information, but related to detecting when a transaction should be aborted.

Page 9 of 12

Ma teaches a database of objects that uses user feedback to categorize objects. As users interact with the database objects, the system learns how objects should be organized by clustering them according to the search string and the results chosen by users. Ma teaches that random objects are inserted in each search iteration along with objects believed in a cluster. Ma, col. 2, lines 63-67.

First Missing Limitation: Network Content Directory

All claims require network content directory that receives content directories. Prasad relates to a distributed database that includes things such as printers, users, servers, and applications. Such a distributed database is not a network content directory. Blood and Ma are not network content directories either.

Second Missing Limitation: Directory Listing of Class of Objects

Claims 1, 8 and 15 generally require a directory listing content objects identified with a content object class. This content object class has to do with how the content object is perceived by a human. For example, one class is sports and would include football. Although Ma is cited for this proposition, Ma presents both objects in the class and randomly selected objects that are not in the class. Ma, col. 2, lines 63-67. Reliance upon Ma for this teaching is believed inappropriate.

Third Missing Limitation: Reporting Directory In Response to Timer

Claims 8 and 15 generally require reporting of the directory in response to detecting a timer value. Blood is cited for this proposition, but Blood uses a timer for a completely different purpose. Indeed, Blood uses the timer to determine when a transaction should be aborted. Blood, Fig. 3A.

Apparent Official Notice

If the Applicants follow the argument in the Office Action, official notice is apparently relied upon by the Office for several missing limitations. Office Action, ¶15, first paragraph, last line; ¶15, second paragraph, last two lines; ¶24, first paragraph, last line; and ¶24, second paragraph, last two lines. If official notice is being proposed and maintained for these

limitations, Applicants respectfully traverse this official notice and hereby request an express

showing of documentary proof of this proposition as set forth in MPEP 2144.03.

Motivation to Combine Prasad et al. in view of Blood et al. and/or Ma et al.

The first prong of the test requires, a suggestion or motivation to combine

references to avoid hindsight reconstruction of the claimed invention based upon the information

disclosed in the present application. The following excerpt is believed apt in the present case:

> "In the instant application, the examiner has done little more than cite references
> to show that one or more elements or subcombinations thereof, when each is
> viewed in a vacuum, is known. The claimed invention, however, is clearly
> directed to a combination of elements. That is to say, appellant does not claim
> that he has invented one or more new elements but has presented claims to a new
> combination of elements. To support the conclusion that the claimed combination
> is directed to obvious subject matter, either the references must expressly or
> impliedly suggest the claimed combination or the examiner must present a
> convincing line of reasoning as to why the artisan would have found the claimed
> invention to have been obvious in light of the teachings of the references." Ex
> parte Clapp, 227 USPQ 972, 973 (B.P.A.I. 1985)

If the Applicants follow the argument in the Office Action, official notice is

apparently relied upon again to combine these references because no cite to any reference is

provided. Office Action, ¶8, last line; ¶15, last line; page 10, first paragraph, last sentence; and

¶24, last line. If official notice is being proposed and maintained for the proposition that there is

some type of motivation to combine these references, Applicants respectfully traverse this

official notice and hereby request an express showing of documentary proof of this proposition

as set forth in MPEP 2144.03.

The only way this combination of these references makes any sense is to use the

Applicant's claims as a template, which is impermissible hindsight reconstruction. Specific

motivation relevant to the claimed limitations is respectfully requested in any further office

action without improper reliance on official notice.

Reasonable Likelihood of Success

The second prong of the test requires a reasonable likelihood of success in making

the suggested combination. As understood by the Applicants, Prasad is combined with a
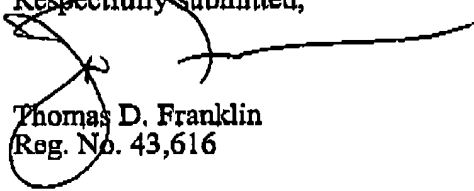
PATENT

transaction abort timer from Blood and a clustering feature of Ma. Picking and choosing features and inserting them for different purposes in the suggested manner for such complex systems would have little likelihood of success without undue experimentation. To say differently, trivializes the substantial effort required to design and implement these types of systems.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance and an action to that end is urged. Reconsideration of the claims in their current form is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Respectfully submitted,

Thomas D. Franklin
Reg. No. 43,616

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, Eighth Floor
San Francisco, California 94111-3834
Tel: 303-571-4000
Fax: 415-576-0300
TDF:cmb

60231682 v1

Page 12 of 12